

Appl. No. 10/758,065
Docket No. 9149Q
Amdt. dated January 5, 2007
Reply to Office Action mailed on October 5, 2006
Customer No. 27752

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REMARKS

Claim Status

Claims 1 – 20 are pending in the present application. No additional claims fee is believed to be due. Claims 5, 6 and 20 have been rejected under 35 U.S.C. § 112, second paragraph. Claims 5, 6, and 20 have been amended for clarity. Claims 1 – 20 have been rejected under 35 U.S.C. §§ 102 and 103. It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 5, 6, and 20 have been rejected under 35 U.S.C. § 112, Second Paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regards to claims 5 and 6, the Office Action states that a “Markush group may not use comprising language with the consisting language.” Claims 5 and 6 have been amended for clarity in the language. With regard to Claim 20, the Office Action states that there is lack of antecedent basis for “pair or rollers” and that it is not apparent what is being claimed by the phrase “optionally a sensor.” Claim 20 has been amended for clarity.

Applicants respectfully request reconsideration and withdrawal of the rejections.

Rejection Under 35 U.S.C. § 102 Over Huen

Claims 1, 5, 7 – 9, 12, 13, 15 and 16 have been rejected under 35 U.S.C. § 102 as being anticipated by Huen (US Patent No. 5,240,140). Applicants respectfully traverse this rejection.

Huen relates to

A card dispenser (32) comprising a body (33) having a compartment (38) for accommodating a stack of cards (39) and at least one outlet (43) through which cards (39) accommodated in the compartment (38) can be dispensed, transporting mechanism (41) provided in the body (33) and arranged to transport a card (39) from the said stack so accommodated towards the said or one of the said at least one outlet (43), and a random

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device (47) arranged to cause the or some of the cards (39) to be dispensed one by one to a plurality of locations in a random manner.

Abstract. Huen fails to teach each and every element of the claims. Huen fails to teach a "product in sheet form." The application defines "a product in sheet form" as "a web or substrate which releasably carries a composition of matter." Page 16, lines 14 – 15. Huen teaches a dispenser for dispensing cards such as playing cards and fortune telling cards. Col. 1, lines 4 – 7. Playing cards and fortune telling cards have nothing to do whatsoever with webs or substrates which releasably carry a composition of matter.

As Huen fails to teach each and every element of the claims, Applicants respectfully request reconsideration and withdrawal of the rejection.

Rejection Under 35 U.S.C. § 102 Over Gergek

Claims 1 – 5, 8 – 9, 13 – 18, and 20 have been rejected under 35 U.S.C. § 102 as being anticipated by Gergek (US Publication No. 2002/0033405). Applicants respectfully traverse this rejection.

Gergek relates to

An automatic rolled tissue dispensing system, which includes a housing within which is located a tissue advancing element comprising a pair of feed rollers which pull the tissue product from a roll of continuous rolled tissue product and advance the tissue to a sheet separating element comprising a pair of tearing rollers which remove individual tissue sheets from the continuous roll.

Abstract. Gergek fails to teach each and every element of the claims. Gergek fails to teach a "product in sheet form" as defined as a "web or substrate which releasably carries a composition of matter." Page 16, lines 14 – 15. Gergek does not teach the dispensing of a product in sheet form in a non-downwards direction. The application defines "downward direction" as "a direction within 45 degrees of the gravitational force vector" and "non-downward direction" as "any direction which is not a downward direction." Page 4, lines 27 – 29. Gergek states that "paper sheets then slide down the top surface of the guide 63. To ensure that the paper sheets slide down the guide smoothly, the guide can be coated with a material such as Teflon." Paragraph 34. The contents of Gergek, therefore, are dispensed in a downwards direction.

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As Gergek fails to teach each and every element of the claims, Applicants respectfully request reconsideration and withdrawal of the rejection.

Rejection Under 35 U.S.C. § 102 Over West

Claims 1, 3 – 4, 7 – 10, and 15 – 18 have been rejected under 35 U.S.C. § 102 as being anticipated by West (US Patent No. 2,440,993). Applicants respectfully traverse this rejection.

West relates to paper towels and dispensing cabinets for the same, and, more particularly, to folded paper towels and means for delivering such towels one at a time from a container or cabinet. Col. 1, lines 1 – 5.

West fails to teach each and every element of the claims. West fails to teach a “product in sheet form” as defined as a “web or substrate which releasably carries a composition of matter.” Page 16, lines 14 – 15. West fails to teach the dispensing of a product in sheet form in a non-downward direction. West states that “[t]he bottom of the housing has the usual discharge opening or slot 12 (see Figs. 8 and 9) through which the towel is delivered.” Col. 2, lines 31 – 33. As stated and as illustrated by figures 8 and 9, West is clearly indicating a downward dispensing of the product contained within the container.

As West fails to teach each and every element of the claims, Applicants respectfully request reconsideration and withdrawal of the rejection.

Rejection Under 35 U.S.C. § 103(a) Over West

Claims 1, 3 – 5, 7 – 10, and 15 – 18 have been rejected, in the alternative, as being obvious over West. Applicants respectfully traverse this rejection.

To establish a case of *prima facie* obviousness, the Office must show a motivation to modify the reference in the manner claimed and a reasonable expectation of success resulting from the combination and modification. This suggestion of the desirability of the modification must come from the teachings of the prior art itself and not from the Applicant’s own disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Obviousness, further, is based on the following factual inquiries: 1) determining the scope

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and contents of the prior art; 2) ascertaining the differences between the prior art and the claims in issue; 3) resolving the level of ordinary skill in the pertinent art; and 4) evaluating evidence of secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The Office has not established a *prima facie* case of obviousness because there is no evidence of the factual inquiries being made or of a motivation to modify the reference.

While the Office Action appears to reject multiple claims under 35 U.S.C. § 103, only claim 5 is discussed with the Office Action stating that "it would have been obvious...to make a roller comprising some componentry comprised of plastic material or composite materials to provide sufficient stiffness while having sufficient rotational wear resistance to have a marketable longevity..." West, however, fails to teach or suggest each and every element of the claims.

As noted above, West fails to teach a product in sheet form such as a web or substrate which releasably carries a composition of matter and West specifically teaches a downward dispensing of the product contained within the container.

The Office has failed to put forth any motive as to why one of ordinary skill would modify West to arrive at the claims of the current application when West specifically teaches away from a non-downward dispensing of product and fails to teach a product in sheet form such as a web or substrate which releasably carries a composition of matter.

As West fails to teach or suggest each and every element, Applicants respectfully request reconsideration and withdrawal.

Rejection Under 35 U.S.C. § 103(a) Over Washington in view of Winkler

Claims 1, 5 – 6, 15 – 16 and 18 – 20 have been rejected as being obvious over Washington et al. (US Patent No. 6,976,634) ("Washington") in view of Winkler et al. (US Patent No. 4,877,230) ("Winkler"). Applicants respectfully traverse this rejection.

Washington is directed to

An ATM currency cassette includes an RFID tag. The tag includes information about the cassette, such as the cassette serial number and the

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currency denomination. An ATM includes a tag reader that can interrogate the tag to receive the information. The history of a particular cassette can be tracked via the cassette serial number. Problem cassettes can be identified.

Abstract. The Office Action utilizes Winkler to support the teachings of Washington. Winkler is directed to

A sheet dispenser for selectively dispensing predetermined numbers of sheets, for example, paper currency of different denominations and having plural input stations each receiving a stack of each bill denomination. A feed roller at each station has a high friction surface portion which engages a bottom sheet and feeds the sheet between the feed roller and a cooperating stripper shoe to assure single sheet feeding. An elongated acceleration belt extends beneath all of the feed rollers. Cooperating acceleration pinch wheels form a nip with the belt for accelerating a sheet entering the nip. A curved resilient guide cooperates with each feed roller to guide sheets passing the stripper shoe toward its associated acceleration nip. The sheets pass along the acceleration belt to an outfeed stacker including a stacker wheel to facilitate the formation of a neat stack of sheets. Sensors detect the entry of a sheet into each acceleration nip and to assure proper positioning of the feed roller. Notches provided in each feed roller adjacent to the leading edge of the high friction surface assure movement of the leading edge of the sheet into the nip formed by the feed roller and stripper shoe to enhance sheet feeding. The drive motor for each feed roller rotates one revolution for each sheet to be dispensed. A microprocessor-based electronic control operates the motors to dispense a mix of denominations to preferably minimize the number of bills dispensed. An override is provided to alter the mix of the denominations. In the event that a sensor fails to sense the delivery of a bill to its associated acceleration nip the dispensing operation may be automatically repeated at least once.

Abstract. The Office Action states only that "it would have been obvious...to use nip rollers to get a more positive grip on the currency as taught by Winkler et al...It would have been obvious...to use plastic coated rollers with metal cores to get a predictable long term positive grip on the currency and length wear of components as taught by Winkler et al..." The combination of Washington and Winkler, however, fails to teach or suggest each and every element of the claims.

Washington fails to teach or suggest a product in sheet form. The application has defined "product in sheet form" as a "web or substrate which releasably carries a

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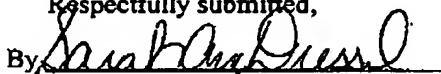
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composition of matter." Page 16, lines 14 ~ 15. Washington is directed to dispensers for currency. Paper currency is not considered a web or substrate which releasably carries a composition of matter. Winkler fails to overcome this lack of teaching of a product in sheet form as Winkler is also directed to a dispenser of currency. The Office Action has not put forth any motivation as to why one of ordinary skill would look to dispensers of currency to arrive at the instant claims.

As the combination of Washington and Winkler fails to teach or suggest each and every element of the claims, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Conclusion

This response represents an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied references. In view of the foregoing, entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims are respectfully requested.

Respectfully submitted,
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